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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,909	11/24/2003	Roland Janzen	DCS-9151	5291

34500 7590 10/04/2007  
DADE BEHRING INC.  
LEGAL DEPARTMENT  
1717 DEERFIELD ROAD  
DEERFIELD, IL 60015

EXAMINER
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VENCI, DAVID J

ART UNIT	PAPER NUMBER
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1641

MAIL DATE	DELIVERY MODE
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10/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/720,909

Applicant(s)

JANZEN ET AL.

Examiner

David J. Venci

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on July 26, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-12 and 14-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

In prior Office Action, claims 7, 8 and 12 were withdrawn from consideration pursuant to 37 CFR 1.142(b) for being directed to a non-elected invention. However, Applicants did not understand why Examiner interpreted claim 7 as being patentably distinct (see prior Office Action for explanation).

For purposes of the following restriction requirement, claims 7 and 12 are interpreted as follows:

7. A reagent comprising:

- (1) a fluid medium ~~containing~~; containing;
- (2) a binding species attached to a substrate said binding species capable of disassociating from the substrate;
- (2) a porous material including (a) an outer surface porous to dissociated binding species but not to the binding species attached to the substrate and (b) an inner surface having an affinity for said binding species.

12. A reagent, comprising:

- a fluid medium ~~containing~~; containing;
- a first substrate;
- a first binding species, wherein a first portion of the first binding species is attached to the first substrate and a second portion of the first binding species is dissociated from the first substrate; and
- a second substrate having regions adapted to selectively bind the second portion of the first binding species.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 drawn to a reagent comprising, *inter alia*, two distinct binding entities, classified in class 435/7.1, for example.
- II. Claims 7 and 8, drawn to a reagent comprising, *inter alia*, porous material, classified in class 436/523, for example.
- III. Claims 9-11, drawn to a method comprising, *inter alia*, a step of providing a container, classified in class 435/395, for example.
- IV. Claim 12, drawn to a reagent comprising, *inter alia*, a binding species with two distinct portions, classified in class 435/69.7, for example.
- V. Claims 14-16, drawn to a reagent comprising, *inter alia*, a substrate with two distinct regions, classified in class 435/288.4, for example.
- VI. Claims 17-21, drawn to a method comprising, *inter alia*, a step of providing a fluid medium, classified anywhere in class 210, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, IV and V are related products. Related products are distinct from each other if the products, as claimed, are not: (1) capable of use together or have a materially different design, mode of operation, function, or effect; (2) overlapping in scope, i.e., are mutually exclusive; and (3) obvious variants. See MPEP § 806.05(j).

Here, Inventions I, II, IV and V have different designs because Invention I requires two distinct binding entities, while Invention II requires porous material, while Invention IV requires a binding species with two distinct portions, while Invention V requires a substrate with two distinct regions.

The scopes of Inventions I, II, IV and V do not appear to overlap because Invention I requiring two distinct binding entities does not appear to infringe Invention II requiring porous material, which in turn, do not

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appear to infringe Invention IV requiring a binding species with two distinct portions, which in turn, do not appear to infringe Invention V requiring a substrate with two distinct regions. In addition, Applicants have not indicated on the record a specific example of a single product that infringes two or more of Inventions I, II, IV and V.

Inventions I, II, IV and V are not obvious variants because the aforementioned differences between Inventions I, II, IV and V require different structures, and there is no indication on the record that the structures would have been obvious variants over each other within the meaning of 35 U.S.C. 103(a).

Inventions (I, II, IV or V) and (III or VI) are related as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products of Inventions (I, II, IV or V) can be used in a materially different process, such as a process for assaying first binding species.

Inventions III and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the inventions have different modes of operation because Invention III requires a step of providing a container, while Invention VI requires a step of providing a fluid medium.

Examination burden is established because the scope of prior art search required for each Invention does not appear coextensive. For example, a search for the two distinct binding entities of Invention I requires a search of prior art related to specific binding assays, while a search for the porous material of Invention II requires a search of prior art related to particulates, while a search for the step of providing a container of Invention III requires a search of prior art related to cell culturing, while a search for the binding species

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with two distinct portions of Invention IV requires a search of prior art related to fusion proteins, while a search for the substrate with two distinct regions of Invention V requires a search of prior art related to microarrays, while a search for the step of providing a fluid medium of Invention VI requires a search of prior art related to liquid chromatography.


As indicated, *supra*, restriction for examination purposes is proper because the inventions are distinct and require separate, non-coextensive searches of the prior art.

Applicant is advised that a complete reply to this requirement must include: (i) an election of an invention to be examined even if the requirement is traversed<sup>1</sup> (37 CFR 1.143), and (ii) identification of the claims encompassing the elected invention. An argument that claims are allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Venci whose telephone number is 571-272-2879. The examiner can normally be reached on 08:00 - 16:30 (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

David J Venci  
Assistant Examiner  
Art Unit 1641

djv

  
LONG V. LE 09/28/07  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

<sup>1</sup> Applicant may elect an invention or species with traverse or without traverse. To reserve a right to petition, Applicant must elect with traverse. Should Applicant traverse on the ground that the inventions or species are not patentably distinct, Applicant should clearly admit on the record, or submit or identify evidence on the record that the inventions or species are obvious variants. If Examiner finds one Inventions unpatentable over the prior art, Examiner may use the evidence or admission of record to reject other inventions under 35 U.S.C.103(a).